

REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated December 3, 2008.

Claims 1-17 are pending in the instant application. Claim 8 has been withdrawn from consideration pursuant to Examiner's Restriction Requirement, and Applicant's election.

Rejection under 35 U.S.C. § 102

Claims 1, 2 and 12 are rejected under 35 U.S.C. § 102(e) as anticipated by Kimura (2002/0135891). Applicant respectfully traverses the rejection, for at least the following reasons.

The Office Action largely repeats text of its previous rejection, altering only to assert that Kimura teaches the features added by Applicant's September 9, 2008 amendment, though offering no additional support for the assertion. Therefore, to the extent that these features are addressed in the Response to Arguments (Office Action, p. 8), Applicant responds as follows.

The Office Action asserts that "the claim does not require that the spherical aberration vary from device to device as a result of manufacturing and adjustment errors" (Office Action, p. 8). In fact, claim 1 recites

...one or more aberration correction optical elements which
...correct aberration of [] light generated within [a] path and
caused by manufacturing and adjustment errors of the optical
components which vary from one such optical head device to
another...

Similarly, independent claim 12 recites

...measuring aberration generated in a light path within the
optical system from said light source to said objective lens and
caused by manufacturing and adjustment errors of the optical
components which vary from one such optical head device to
another...

Initially, Applicant agrees that the claims do not require that the aberration being corrected is a spherical aberration, and further that the aberration to be corrected according to the above-noted claims is the result of manufacturing and adjustment errors. Applicant's reference to spherical aberration was a reference to Kimura, because that is the nature of aberration it is directed to correcting.

The Office Action cites to para. [0075] and para. [0157] of Kimura, and asserts that these teach the aberrations being corrected vary from device to device based upon manufacturing defects. Applicant respectfully disagrees. At para. [0057], Kimura discloses

...a spherical aberration correction means for correcting the variation of the spherical aberration generated on each optical surface of the light converging optical system **due to at least 2 combinations of the temperature•humidity change, variation of the transparent substrate thickness of the information recording medium, and the variation of the oscillation wavelength of the light source...**
(emphasis added)

All of the factors introducing the spherical aberration to be corrected: temperature or humidity change, variation of the media substrate thickness, and variation of the light source wavelength; are not caused by manufacturing or adjustment errors. These factors are run-time variances in operational environments, and they are not fixed at the time of manufacture. Turning then to para. [0157], Kimura discusses the variation with temperature of a plastic objective lens, particularly at high values of NA (a numerical aperture). As already noted, temperature variation, and the spherical aberration caused by it to be corrected according to Kimura, is not “caused by manufacturing and adjustment errors” as recited in the independent claims. Temperature variations are the result of operational environment, and may or may not be present upon testing at the point of manufacture, and therefore may or may not be detected to be subsequently corrected. Therefore, Applicant respectfully submits that, contrary to the assertion in the Office Action, Kimura does not disclose or suggest that the aberration to be corrected is caused by manufacturing or adjustment errors.

The Office Action further dismisses Applicant’s argument that Kimura does not teach or suggest “said one or more aberration correction optical elements are selected from amongst a plurality of different aberration correction optical elements” recited in claim 1, nor “selecting, from amongst a plurality of different aberration correction optical elements, based on the results of the measured aberration, one or more aberration correction optical elements” as recited in claim 12. In rejecting this contention, the Office Action again asserts that “Kimura discloses the correction of a spherical aberration caused by manufacturing and adjustment errors (pars. 75 and 157).” (Office Action, p. 9) As demonstrated above, this contention with respect to Kimura is in error. Even so, the teaching attributed to Kimura does not fairly meet the relevant claim features. The claim feature pertains to the selection of a correction optical element, while the Office Action asserts, although in error, that Kimura teaches the noted source of the aberration to be corrected. The Office Action’s position therefore lacks substantial evidence support.

The Courts have very recently reiterated the strict identity required for anticipation. “Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’ ” *Net MoneyIN, Inc., v. Verisign, Inc.*, ___ F.3d ___ (Fed. Cir., Oct. 20, 2008) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)); *see also*, *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir., 1984). Therefore, Applicant respectfully submits that claims 1 and 12 are patentably distinguished over Kimura.

Claim 3 depends from claim 1, and incorporates all features of claim 1 by reference. Although claim 3 is separately patentable, in the interest of brevity Applicant offers claim 3 as patentable for at least the same reasons as its underlying independent base claim. Therefore, Applicant respectfully submits that the rejection has been obviated, and kindly requests favorable reconsideration and withdrawal.

Rejection under 35 U.S.C. § 103

Claims 2, 4-5, 9-10 and 13 are rejected under 35 U.S.C. §103(a) as obvious over Kimura in view of alleged Applicant Admitted Prior Art (“AAPA”). Claims 6 and 11 are rejected under 35 U.S.C. §103(a) as obvious over Kimura in view of Minoura (4,139,267). Claim 7 is rejected under 35 U.S.C. §103(a) as obvious over Kimura, in view of Abe (6,084,843). Claim 14 is rejected under 35 U.S.C. §103(a) as obvious over Kimura in view of Sano, *et al.* (6,967,916). Claims 15-17 are rejected under 35 U.S.C. §103(a) as obvious over Kimura, in view of Ogawa, *et al.* (5,126,994). Applicant respectfully traverses the rejections.

Each of claims 2-7, 9-11 and 15-17 depend, directly or indirectly from independent claim 1. Each of claims 13-14 depend from independent claim 12. These dependent claims incorporate by reference the features of their respective underlying independent base claims.

The grounds of obviousness rejection are premised upon the application of Kimura to underlying independent base claims 1 and 12, which has been obviated above. None of the foregoing references offer, nor are any alleged to, any teaching or suggestion to ameliorate the deficiencies of Kimura with respect to claims 1 and 12. Therefore, even presuming without conceding that the references teach what is attributed to them or Applicant’s specification makes the alleged admission(s), and further presuming that there is some apparent reason for one of

ordinary skill in the art to the combine the references as proposed in the Office Action, even taken in combination the references do not teach all elements recited in the claims. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Therefore, Applicant respectfully submits that dependent claims 2-7, 9-11 and 13-17 are patentably distinguished over the applied references, taken singly or in any combination. Favorable reconsideration and withdrawal of the rejections is kindly requested.

Conclusion

In light of the foregoing, Applicant respectfully submits that all claims recite patentable subject matter.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

THIS CORRESPONDENCE IS BEING
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Respectfully submitted,



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